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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/915,395

07/27/2001

Shinji Baba

7091

22852

7590

09/23/2005

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EXAMINER

ALI, MOHAMMAD

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/915,395

Applicant(s)

BABA ET AL.

Examiner

Mohammad Ali

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/27/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to the application filed on 7/27/01.

The application has been examined and claims 1-20 are pending in this Office Action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "A school searching method" in claim. There is insufficient antecedent basis for this limitation in the claim (e.g., adding a computer-implemented method would be overcome this rejection).

Regarding claim 18, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 1, 9, and 17 the phrase "the searching student" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Art Unit: 2167

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1-9, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergan et al. ('Bergan' hereinafter), USP, 6,322,366 in view of Eisendrath et al. ('Eisendrath' hereinafter), USP, 6,347,333.

With respect to claim 1,

Bergan teaches a school searching method for searching information concerning schools conforming to the searching student (see col. 1, lines 13-15) comprising:

obtaining an ability characteristic indicating ability level (col. 2, lines 25-34, Bergan) in a current academic stage of the searching student (col. 5, lines 26-29, Bergan);

setting a target condition in a target stage of the searching student (col. 42, lines 43-49, Bergan); and

searching at least one route school located in a intermediate academic stage between said current academic stage and said target stage (col. 37, lines 42-45, Bergan), said at least one route school conforming to said ability characteristic and forming a target achieving course suitable for the searching student to reach said target condition (col. 38, lines 55-58, Fig. 175 et seq., Bergan).

Bergan does not explicitly indicate claimed conforming ability.

Eisendrath teaches conforming ability (the worksheet can include information outlining the requirements “conforming” of a pending element included in the syllabus, see col. 9, lines 21-23, Eisendrath).

It would have been obvious to one ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because the conforming ability of Eisendrath’s teaching would have allowed Bergan’s system to achieve academic and career guidance in the details of the student learning experience as suggested by Eisendrath at col. 2, lines 1-2. Further, conforming ability as taught by Eisendrath improves students capabilities in greater detail than is possible using only a final course grade or grade point average (see col. 2, lines 8-9, Eisendrath).

As to claim 2,

Bergan teaches wherein the step of searching the route school comprises searching the route school conforming to the ability characteristic as well as the condition for a next stage, in a direction reverse to the academic progressing direction, with the target stage as the starting point (col. 37, lines 42-45, Bergan).

As to claim 3,

Bergan teaches wherein the step of searching the route school comprises selecting a school constituting a consecutive school group as the route school forming the target achieving course (col. 1, lines 21-22 et seq, Bergan), said consecutive school group constituting schools belonging to a plurality of intermediate academic stages adjacent to each other and each having continuity (col. 37, lines 42-45, Bergan), and wherein the school constituting the consecutive school group is selected as the route school when the lower stage school of the consecutive school group conforms to the ability characteristic and when the upper stage school of the consecutive school group conforms to the condition of next stage (col. 2, lines 50-52, Bergan).

As to claim 4,

Bergan teaches, wherein the step of searching the route school comprises searching the route school based on easy-accessibility of the whole target achieving course (col. 1, lines 21-22 et seq, Bergan) obtained from easy-accessibility of each stage movement between the current academic stage and the target stage (col. 2, lines 29-33, Bergan).

As to claim 5,

Bergan teaches wherein said target condition of said target stage is an occupation in an employment stage (col. 25, lines 30-31, Figs. 49, 11, Bergan).

As to claim 6,

Bergan teaches wherein said target condition of said target stage is a university in a university stage (col. 15, lines 32-33, Bergan).

As to claim 7,

Bergan teaches obtaining a desired condition indicating desire of the searching student with respect to the route school, wherein the step of searching the route school comprises searching the route school conforming to said desired condition (col. 18, lines 10-14 et seq, Bergan).

As to claim 8,

Bergan teaches wherein said desired condition includes location of the route school (col. 14, lines 64-65, Fig. 7 et seq, Bergan).

Claims 9-16 have the same subject matter as of claims 1-8 respectively and essentially rejected for the same reasons as discussed above.

Claims 17, 19, and 20 have the same subject matter as of claim 1 and essentially rejected for the same reasons as discussed above.

With respect to claim 18,

Bergan teaches a school searching system (see col. 1, lines 13-15) comprising:  
a school searching WWW server which may be accessed (col. 2, lines 25-34 and col. 13, lines 28-29, Bergan) by the user terminal used for the searching student (col. 5, lines 26-29, Bergan); and

a school searching server to search information regarding the school conforming to the searching student based on the information of the searching student acquired from the user terminal through the school searching WWW server (col. 2, lines 25-34 and col. 13, lines 28-29, Bergan), said school searching server including: an ability obtaining section for obtaining ability characteristic indicating ability level in a current academic stage of the searching student (col. 37, lines 42-45, Bergan);

a target setting section for setting a target condition in a target stage of the searching student (col. 42, lines 43-49, Bergan); and

a route school searching section for searching at least one route school located in an intermediate academic stage between said current academic stage and said target stage, said at least one route school conforming to said ability characteristic and forming a target achieving course suitable for the searching student to reach said target condition, wherein said school searching WWW server (col. 2, lines 25-34 and col. 13, lines 28-29, Bergan) provides the information of the searching result obtained from said school searching server to the user terminal after processing the information for providing it to the user terminal (col. 38, lines 55-58, Fig. 175 et seq., Bergan).

Bergan does not explicitly indicate claimed conforming ability.

Eisendrath teaches conforming ability (the worksheet can include information outlining the requirements “conforming” of a pending element included in the syllabus, see col. 9, lines 21-23, Eisendrath).

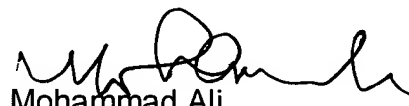
It would have been obvious to one ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because the conforming ability of Eisendrath’s teaching would have allowed Bergan’s system to achieve academic and career guidance in the details of the student learning experience as suggested by Eisendrath at col. 2, lines 1-2. Further, conforming ability as taught by Eisendrath improves students capabilities in greater detail than is possible using only a final course grade or grade point average (see col. 2, lines 8-9, Eisendrath).

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mohammad Ali  
Primary Examiner  
Art Unit 2167

MA  
September 17, 2005